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REMARKS

The Examiner has maintained the rejection of the claims. While applicant continues to disagree with the Examiner, applicant has incorporated the subject matter of at least one dependent claim into each of the independent claims in the spirit of expediting the prosecution of the present application. Since the subject matter of such dependent claim(s) was already considered by the Examiner, it is asserted that such claim amendments would **not** require new search and/or consideration.

Claims 1-3, 5, 17-19, 21, 33-35, 37, 49-51, 53, 65-67, 69, 81-83 and 85 stand rejected under 35 USC §102 as being anticipated by Cozza (U.S. Patent 5,649,095). Applicant respectfully disagrees with such rejection, particularly in view of the amendment made hereinabove. Specifically, the subject matter of Claims 4, 10 and 13 et al. has been incorporated into each of the independents claims, along with any intervening claims.

With respect to the subject matter of former Claim 10 et al. (now incorporated into each of the independent claims), the subject matter of such claim is rejected under 35 USC §103 as being unpatentable over Cozza as previously applied to applicants' independent claims and further in view of Hyppönen (U.S. Patent 6,577,920). Specifically, the Examiner relies on the excerpt from Cozza below to meet applicant's claimed technique "wherein said fingerprint data includes a number of program resource items specified within said resource data" (see this or similar, but not necessarily identical language in each of the independent claims).

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"The simplest method to accomplish this is to look for a
predetermined string of hexadecimal bytes, the presence of which
indicates a specific virus infection." (see col. 1, lines 63-65)

"A third example involves the nature of multi-fork file storage
on computers such as the Apple Macintosh. Typically one fork of a
file, for example the resource fork on Macintosh computers, may
contain a kind of small database which is used to contain many
kinds of data, including application code, icons, preferences,
strings, templates, and other such items. A change in size to
such a fork may not indicate a change to application code, but
rather a change to something else such as user preferences. It is
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therefore necessary to handle this complexity in a proper manner
so as to optimize speed enhancement without compromising scan
effectiveness." (see col. 2, paragraph 7)

The Examiner goes on to argue that "the combination of Cozza and Hypponen disclosed the signature including multiple resource items." First, Hypponen merely discloses generating fingerprint data for a macro file. Further, the above excerpt merely discloses exemplary resource data.

Simply nowhere in either of the references is there even a suggestion of a number of program resource items specified within resource data, as claimed. Only applicant teaches and claims including, in a fingerprint, a number of program resource items within resource data. By this design, such number may be used to enhance the efficiency or overall effectiveness of the scanning when the fingerprint data is compared with fingerprint data of known computer program.

Still yet, with respect to the subject matter of former Claim 13 et al. (now incorporated into each of the independent claims), the subject matter of such claim is rejected under 35 USC §103 as being unpatentable over Cozza as previously applied to applicants' independent claims and further in view of Hyppönen (U.S. Patent 6,577,920). Specifically, the Examiner relies on the excerpt from Cozza below to meet applicant's claimed technique "wherein said fingerprint data includes a flag indicating which data is included within said fingerprint data" (see this or similar, but not necessarily identical language in each of the independent claims).

"The process for scanning each file in a volume will now be
described with reference to FIGS. 4A through 4E. In this process
two sets of flags are used. The first is in memory and is used to
determine the viruses for which a particular file needs to be
scanned during the current virus scan. For this set of flags the
system utilizes a bit field large enough so that there is one bit
corresponding to every known Macintosh virus. Currently the
number of Macintosh viruses is less than 50. Therefore, a
bitfield of 128 bits (or 4 longwords) in length is adequate to
handle current viruses and those that will appear for some time
to come. This field could be enlarged as needed. Bits in this
bitfield are turned on in steps 68, 76, and 80, which are
described below, to indicate the viruses for which the system
scans in a particular file, as also described below in connection

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with steps 90 and 94.
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The second set of flags resides in the cache information (see
FIG. 5). One longword of memory is generally adequate for this. A
value of zero in this longword would indicate that no virus was
found previously in the last scan of the file. As described
below, this flag is set in step 102. If a virus was found in the
last scan of this file, then 3 bytes in this longword can be used
to indicate which virus was found first in the file. The
remaining 8 bits can be used to indicate whether (1) one or more
viruses which change resource fork lengths were found in the last
scan of this file, (2) one or more viruses which change data fork
lengths were found in the last scan of this file, and (3) whether
multiple viruses were found in the last scan of this file. Other
bits could be used to indicate whether a virus which does not
change fork size was found in the last scan of this file, etc.
These other indications, however, are not necessary. The setting
of this set of flags will be more fully described below in
connection with step 98." (see col. 5, paragraph 3 et al.)
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The above excerpt, however, merely discloses a flag that identifies viruses to be scanned for during scanning, as well as scanning results. This is a paramount departure from applicant's technique "wherein said fingerprint data includes a flag indicating which data is included within said fingerprint data" (emphasis added), as claimed. Only applicant teaches and claims such a specific flag in fingerprint data, which specifically indicates which data is included within said fingerprint data. By this feature, such information may be used to enhance the efficiency or overall effectiveness of the scanning when the fingerprint data is compared with fingerprint data of known computer program.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck,* 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir.1991).

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Applicant respectfully asserts that at least the third element of the *prima facie* case of obviousness has not been met, since the prior art references, when combined, fail to teach or suggest all of the claim limitations, as noted above. A notice of allowance or a specific prior art showing of all of applicant's claim limitations, in combination with the remaining claim elements, is respectfully requested.

Thus, all of the independent claims are deemed allowable. Moreover, the remaining dependent claims are further deemed allowable, in view of their dependence on such independent claims.

In the event a telephone conversation would expedite the prosecution of this application, the Examiner may reach the undersigned at (408) 505-5100. The Commissioner is authorized to charge any additional fees or credit any overpayment to Deposit Account No. 50-1351 (Order No. NAI1P467/00.177.01).

Respectfully submitted,

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